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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,240	03/15/2004	Aaron M. Lamstein	545.41	2033
85444 7590 01/08/2010 Bay Area Technology Law Group PC 500 Sansome Street, Suite 404 San Francisco, CA 94111				
EXAMINER				
VALENTI, ANDREA M				
ART UNIT		PAPER NUMBER		
3643				
MAIL DATE		DELIVERY MODE		
01/08/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/801,240

Applicant(s)

LAMSTEIN, AARON M.

Examiner

ANDREA M. VALENTI

Art Unit

3643

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,305,318 to Ford in view of U.S. Patent No. 6,435,133 to Wayne.

Regarding Claim 1, Ford teaches a pet bed for use by cats (Col. 1 line 11), said pet bed comprising a resilient, compressible fill material (#13), and an outer shell fabric (#2) defining the geometry of the pet bed as having a bottom and sides and a top, the later comprising a gas permeable fabric (Col. 2 line 24-29), a closable opening in said outer shell fabric allowing for selective access to the interior of said outer shell fabric (Fig. 2 #9), a gas permeable pouch (#19) containing catnip located beneath said top fabric such that scent from said catnip is caused to permeate through the said gas permeable pouch and gas permeable top fabric.

Ford is silent on explicitly teaching that the catnip pouch is located within the closable opening. However, merely shifting the location of a known element performing the same intended function of providing a removable scent that attracts cats, shifted for the motivation to prevent easy access by the animal, does not present a patentably distinct limitation over the prior art of record [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)].

Ford teaches a canvas-like fabric (Ford denim Col. 2 line 28), but is silent on explicitly teaching a plush fabric. However, Wayne teaches a pet bed for use by cats that has a plush fabric surface (Wayne Col. 3 line 29 and Col. 4 line 7-8). Wayne teaches it is known to substitute a plush fabric for a canvas-like fabric. It would have been obvious to one of ordinary skill in the art to modify the teachings of Ford with the teachings of Wayne at the time of the invention to create a more comfortable bed for the animal. The modification is merely the selection of a known alternate material for intended use [Leshin 125 USPQ 416] to obtain predictable results.

Regarding Claim 2, Ford as modified teaches the said gas permeable pouch (#19) containing catnip is located between said resilient compressible fill material and said top fabric (Fig. 5) and in contact with the resilient fill material (Ford as modified with #19 within #9).

Regarding Claims 8 and 9, Ford as modified teaches that the top fabric and pouch materials are sufficiently permeable (Ford Col.2 line 60-65) such that inherently teaches that said top fabric is depressed by the weight of the cat using said pet bed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface or when said gas permeable pouch is squeezed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface occurs when the animal is present on top of the bed.

Regarding Claim 3, Ford as modified is silent on the gas permeable pouch containing catnip is located beneath said resilient compressible fill material and thus separated from the top by the resilient compressible fill material. However, it would

have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention since the modification is merely the shifting location of a known element, for ease of assembly or desired attractive powers, performing the same intended function and does not present a patentably distinct limitation [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)]. Furthermore, applicant has not claimed the orientation of the bed; therefore, if the bed got turned upside down the catnip inherently would be located under the fill material. Thus it is merely a relative limitation to the orientation of the pillow

Regarding Claims 5 and 7, Ford as modified teaches the gas permeable pouch is attached to an interior surface of said top fabric by providing said interior surface with a fabric pocket sized to receive said pouch (Fig. 5); Ford as modified by placing #19 within #9 and closing; merely making a known component integral to prevent displacement does not present a patentably distinct limitation over the prior art of record [*In re Larson*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965)].

Regarding Claim 6, Ford as modified teaches that hook and loop fasteners are a known means of securing things in place (#9), but is silent on said gas permeable pouch is attached to an interior surface of said top fabric by hook-and-loop fasteners. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Ford at the time of the invention with a known fastening means to prevent the catnip from becoming undesirably displaced. [*In re Larson*, 340 F.2d 965, 967, 144 USPQ 347, 349 (CCPA 1965)].

Regarding Claim 4, Ford as modified is silent on said gas permeable pouch is characterized as having a closable opening so that catnip can be periodically refillably introduced to said pouch. However, it is old and notoriously well-known to provide recyclable pouches as an environmentally sound practice to reduce waste. It would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention for the cost reducing and environmentally beneficial results.

Response to Arguments

Applicant's arguments filed 09 November 2009 have been fully considered but they are not persuasive.

Applicant argues that Ford does not teach placing a catnip pouch beneath gas permeable fabric and does not provide a closable opening for the catnip pouch in the outer shell of the fabric. The examiner maintains the previous response and reiterates that it is the examiner's position that Ford teaches a closable opening around the waistband (Ford Fig. 2 #9 and Col.2 line 36-42). Ford does teach that the gas permeable pouch is located beneath the top fabric (Ford Fig.5 #19) since Ford places the pouch in a pocket. The top surface of the pocket is considered to be part of the top fabric of the bed since the pocket is constructed out of the material that is identical to the material covering the fill material. by being in the pocket of Ford, the pouch is under the top fabric. Ford is silent on explicitly teaching that the catnip pouch is located within the closable opening. However, merely shifting the location of a known element performing the same intended function of providing a removable scent that attracts cats, shifted for the motivation to prevent easy access by the animal, does not present a

patentably distinct limitation over the prior art of record [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)].

Furthermore, the modification of shifting the location of the catnip pouch could be viewed merely as "obvious to try" choosing from a finite number of identified, predictable solutions with a reasonable expectation of success.

Applicant argues that Ford does not teach placing the gas permeable pouch containing catnip between the resilient fill material or beneath the compressible fill material and the top fabric. However, the examiner maintains that Ford teaches a resilient compressible fill material (Ford Col. 2 line 57-59) and a shell fabric (Ford Col. 2 line 25-27 element #2). In claim 3, applicant has merely claimed the catnip is located beneath the fill material. Applicant has not claimed the orientation of the bed; therefore, if the bed got turned upside down the catnip inherently would be located under the fill material. Thus it is merely a relative limitation to the orientation of the pillow.

The examiner has not ignored the limitation that the catnip pouch be retained within a closable opening in the outer shell fabric. It is the examiner's position that Ford teaches a pet bed made up of an outer shell fabric with a closable opening and a resilient fill material. Ford teaches securing a catnip pouch to the pet bed and more explicitly actually underneath a layer of the outer shell fabric (i.e. the pocket), but is merely silent about placing the pouch inside the closable opening of the outer shell. Merely shifting the location of a known component performing the same intended function (i.e. attract cats) does not patentably distinguish over the prior art of record. The fact that applicant has recognized another advantage which would flow naturally

from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Claims 8 and 9 are merely functional language claims that fail to further limit the independent claim since it is an apparatus claim and weight is not given to method steps in an apparatus claim. Ford is capable of performing the functions intended in claims 8 and 9.

Examiner maintains that applicant has not patentably distinguished over the teachings of the cited prior art.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDREA M. VALENTI whose telephone number is (571)272-6895. The examiner can normally be reached on 6:00am-4:30pm M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrea M. Valenti/
Primary Examiner, Art Unit 3643

04 January 2010